

**REMARKS**

Claims 1-15 are pending in the present application. Claims 11-15 are withdrawn from consideration. Claims 1-10 are rejected. Claims 1 and 6 are herein amended.

Amendment to claim 6 is supported by page 11, lines 25 to 37 of the original specification. In particular, the amendment is supported by page 11, lines 25 to 28 and 34 to 37. No new matter has been presented.

**Claim Rejections - 35 U.S.C. §102(b)**

Claims 1-4, 6 and 7 remain rejected under 35 U.S.C. §102(b) as being anticipated by Tolliver et al. (U.S. Patent No. 5,069,964).

**Claim Rejections - 35 U.S.C. §103**

Claim 5 remains rejected under 35 U.S.C. §103(a) as being unpatentable by Tolliver et al. (U.S. Patent No. 5,069,964).

Claims 8-10 remain rejected under 35 U.S.C. §103(a) as being unpatentable by Tolliver et al. (U.S. Patent No. 5,069,964) in view of Ojeda et al. (U.S. Patent No. 6,326,072).

The Examiner notes Applicant's argument that the Examiner is incorrectly asserting that the material the cited references would inherently exhibit the claimed functional limitations, i.e., residual rate or fall time of the pressure sensitive adhesive. The Examiner further notes Applicant's argument that the residual rate and the fall time of the pressure-sensitive adhesive layer can be adjusted by forming the pressure-sensitive adhesive layer by, for example,

appropriately setting kinds and contents of a resin and a hardening agent as materials or the pressure-sensitive adhesive layer.

The Examiner relies on MPEP § 2183, and asserts that in the present case, the claimed residual rate and fall time of the pressure sensitive adhesive functional limitations are deemed to be an *inherent* characteristic of the prior art since the prior art is substantially identical in composition and/or structure. The Examiner asserts that “applicant must show evidence that Tolliver does not inherently have the claimed residual rate and fall time of the pressure sensitive adhesive.... Therefore, since Tolliver et al. discloses the same composition for the pressure sensitive adhesive the claimed residual rate and fall time of the pressure sensitive adhesive would be inherent.”

Applicants herein amend the claims to clarify the invention. Thereafter, Applicants traverse the rejections of the claims, and submit that not all of the claimed limitations are taught or fairly suggested by the cited references, alone or in combination.

With particular and further respect to the cited references, Applicants note that Tolliver et al. disclose a rubber-based resin containing acrylonitrile (column 10, lines 54 to 60). However, Applicants note that what is described therein is “nitrile butadiene rubber including both hydrogenated and non-hydrogenated rubbers with varying acrylonitrile content, e.g., from about 10 to about 45 weight percent, and terpolymers such as acrylonitrile/butadiene/isoprene”.

Therefore, though Tolliver et al. disclose various rubber-based resins containing acrylonitrile, they do not disclose acrylic resins containing acrylonitrile.

Still further, there is no description or suggestion indicating that such rubber-based resin compositions inherently exhibit residual rates of the pressure-sensitive adhesive layer and the fall times of the pressure-sensitive adhesive layer in the ranges of the present application.

Applicants respectfully submit that the Examiner is mistakenly relying on an improper section of the MPEP, and not following the proper law with respect to inherency.

Applicants note that MPEP §2112(IV) specifically states that:

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Such is the state of the case law and rules on determining if a claimed limitation is inherently met by a cited reference.

The Examiner cites MPEP §2183 to support her assertion with respect to the inherency, if any, of the cited references.

The MPEP § 2183 is entitled "Making a Prima Facie Case of Equivalence". Portions of the text read as follows:

"If the examiner finds that a prior art element  
    (A) performs the function specified in the claim,  
    (B) is not excluded by any explicit definition provided in the specification for an equivalent, and  
    (C) is an equivalent of the means- (or step-) plus-function limitation,  
the examiner should provide an explanation and rationale in the Office action as to why the prior art element is an equivalent. Factors that will support a conclusion that the prior art element is an equivalent are:  
    (A) the prior art element performs the identical function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification.

(B) a person of ordinary skill in the art would have recognized the interchangeability of the element shown in the prior art for the corresponding element disclosed in the specification.

(C) there are insubstantial differences between the prior art element and the corresponding element disclosed in the specification.

(D) the prior art element is a structural equivalent of the corresponding element disclosed in the specification.

A showing of at least one of the above-noted factors by the examiner should be sufficient to support a conclusion that the prior art element is an equivalent.”

Therefore, Applicants submit that it is clear that each of the above considerations is associated with “means plus function” or “step plus function” claims. MPEP §2183 is associated NOT with rules on determining if a claimed limitation is inherently met by a cited reference, but instead with determining if an asserted equivalent is inherently the same as that disclosed and recited by a means-plus-function claim or step-plus-function claim. Such is not the present case, and therefore, the Examiner’s citation to §2183 is inappropriate.

Applicants have shown and asserted why merely having similar compositional fractions does not *necessarily* lead to the claimed functional limitations being met.

Applicants already asserted that it is necessary to select the kinds and contents of the materials so that the residual rate and the fall time should fall in the ranges of the present invention (page 11, lines 23 to 37, and page 12, lines 1 to 11 of the specification as filed). In other words, one would have to specifically reach for the claimed residual rate and fall time in order to necessarily reach the claimed limitations.

If the Office continues to assert that the limitations of the claimed invention is inherent, Applicants respectfully request from the Examiner the showing of any extrinsic evidence that makes clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.

The Examiner determines that on page 10, line 30 of the specification as filed, Applicant specifies acrylonitrile. However, the acrylonitrile described in page 10, line 30 of the specification as filed is merely described as an illustrative example of other copolymerizable monomers to be copolymerized with acrylic vinyl monomers, and this description is not intended to specify acrylonitrile.

Even though acrylonitrile is contained in part, the characteristics vary with the kind and the content of the acrylic vinyl monomer. Therefore, it cannot be determined that the residual rates and the fall times of the pressure-sensitive adhesive layer should inherently fall in the ranges of the present invention. In other words, it is necessary to select the components in the composition and the contents thereof so that the residual rate and the fall time of the pressure-sensitive adhesive layer fall in the ranges of the present invention.

With regard to claim 6, Applicants note that claim 6 does not require that a rubber-based resin is contained. However, Tolliver et al. do not describe that a cross-linking acrylic copolymer is used, or that a hardening agent is used. Therefore, there is neither description nor suggestion about that a cross-linking acrylic copolymer is used for forming the pressure sensitive adhesive layer, that a hardening agent is used, and that the residual rate and the fall time of the pressure sensitive adhesive layer fall in the ranges of the present invention.

As described above, Tolliver et al. indeed disclose a rubber-based resin containing acrylonitrile, but does not disclose an acrylic resin containing acrylonitrile.

Still further, the description of acrylonitrile in page 10, line 30 of the specification as filed is the description of acrylonitrile as an illustrative example of other copolymerizable

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monomers to be copolymerized with an acrylic vinyl monomer; this description is not intended to specify acrylonitrile.

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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